

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed August 27, 2003. In order to advance prosecution of this case, Applicant amends Claims 1, 2, 5, 20, 39-41, 43, 77-78, 101, and 128. The amendments are not necessarily the result of any prior art reference and thus do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments are without prejudice or disclaimer. Applicant also adds Claims 155-168, which are fully supported by the Application as originally filed. No new matter has been entered by these new claims or the amendments identified above. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 101 Rejections

The Examiner rejects Claims 77-127 under 35 U.S.C. §101 because the claimed invention lacks patentable utility. Although Applicant believes Claims 77-127 to be allowable subject matter as written, Applicant has made clarifying amendments to Claims 77-78, 101, and 128 in order to address the Examiner's concern. Additionally, Applicant reminds the Examiner of the standards and laws associated with this issue. Patentable subject matter is clearly defined as "any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto."¹ When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete, and tangible result. This then satisfies the requirements of 35 U.S.C. §101.² While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. §101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. §101.³ Thus, producing a useful, concrete, and tangible result is the key to patentability according to *State Street* and other applicable case law.

¹ See 35 U.S.C. §101.

² See *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q. 2d 1545, 1558 (Fed. Cir. 1994); see also *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 U.S.P.Q. 2d 1596, 1601-02 (Fed. Cir. 1998).

³ See *AT&T Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the CCPA overturned some of the earlier limiting principles regarding §101 and announced more expansive principles formulated with computer technology in mind); see also *In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (CCPA 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356).

Claims 77-127 produce a useful, concrete, and tangible result and, therefore, are in full accordance with jurisprudence germane to this subject matter. Only in cases where a claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. §101.⁴ Thus, the Examiner's contention is mistaken, as Claims 77-127 are not merely "directed to abstract ideas and, therefore, non-statutory subject matter."⁵ Instead, Claims 77-127 are directed to various methods of routing an object in a transportation network that include a number of limitations, which are clearly within the scope of patentable subject matter as defined by 35 U.S.C. §101. Routing an object in a transportation network provides one of a myriad of practical applications of Claims 77-127. Therefore, the rejection of Claims 77-127 under 35 U.S.C. §101 is improper and, accordingly, Applicant respectfully requests written notice to this effect.

Section 112 Rejections

The Examiner rejects Claim 20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully asserts that the fact Claim 20 does not limit itself to one alternative does not make the claim indefinite. Although Applicant believes Claim 20 to be proper as written, Applicant has made a clarifying amendment to Claim 20 in order to address the Examiner's concern. Thus, Claim 20 should now be allowable and notice to this effect is respectfully requested.

Section 103 Rejections

The Examiner rejects Claims 1-154 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,465,295 issued to Furman ("*Furman*") in view of U.S. Patent No. 5,341,505 issued to Whitehouse ("*Whitehouse*"). This rejection is respectfully traversed for the following reasons.

⁴ See M.P.E.P. §2106.

⁵ See Previous Office Action.

As amended, Claim 1 recites:

A method for routing an object in a transportation network, comprising:
obtaining, at a first point, a first address and a first functional property code associated with the first point;
storing, at a data base, a second functional property code, a second address, and a third address associated with a second point;
determining if the first address is compatible with the second address;
determining if the first functional property code is compatible with the second functional property code if the first address is compatible with the associated second address; and
sending the third address to the first point if the first functional property code is compatible with the second functional property code.

108

Furman and *Whitehouse*, both alone and in combination, fail to disclose, teach, or suggest every element of Claim 1 as amended. For example, *Furman* fails to disclose “obtaining, at a first point, a first address and a first functional property code associated with the first point” and “storing, at a data base, a second functional property code, a second address, and a third address associated with a second point” as provided by Claim 1. *Furman* discloses a toll switching office that is capable of receiving a suffix dialed by a caller. (See *Furman*, col. 4, ll. 4-15.) To the extent the suffix can be construed as a “functional property code”, *Furman* clearly does not disclose “obtaining ... a first functional property code associated with the first point” and “storing, at a data base, a second functional property code ... associated with a second point.” As disclosed by *Furman*, the suffix, both as dialed and as stored, “identifies that one of the subscriber’s plurality of telephone numbers that the caller desires to reach.” (See *Furman*, col. 3, ll. 12.) Thus, inherent in the teachings of *Furman* is its inability to provide an architecture capable of “obtaining, at a first point, a first address and a first functional property code associated with the first point” and “storing, at a data base, a second functional property code, a second address, and a third address associated with a second point.” For at least these reasons, *Furman* fails to disclose, teach, or suggest every element of Claim 1.

Furthermore, Applicant notes that any combination with *Whitehouse* does not remedy this omission. *Whitehouse* discloses a system capable of providing an extended address (ZIP+4) for a destination upon receipt of the street address of the destination. (See Abstract of *Whitehouse*.) However, *Whitehouse* suffers from the same shortcomings as *Furman* in that it also fails to disclose “obtaining, at a first point, a first address and a first functional property code associated with the first point” and “storing, at a data base, a second functional

property code, a second address, and a third address associated with a second point” as recited by amended Claim 1. The Examiner concedes as much with respect to *Whitehouse*, as it was not used by itself as a basis for a §102 rejection: nor was it cited as disclosing the above-identified element of Claim 1 in the context of a §103 rejection. Thus, *Furman* and *Whitehouse*, both alone and in combination, fail to disclose every element of Claim 1 and Claim 1 is allowable for at least this reason. As a result, Applicant respectfully requests reconsideration and allowance of Claim 1 and its corresponding dependent claims.

Amended Claims 39, 77, 101, and 128 also include elements that are similar to Claim 1. Claims 39, 77, 101, and 128 are, thus, allowable for at least those reasons discussed above with respect to Claim 1. Applicant respectfully requests reconsideration of Claims 39, 77, 101, and 128 and their corresponding dependent claims.

Applicant has therefore noted the deficiencies of the §103 rejection proffered by the Examiner. Hence, the Examiner has failed to satisfy each of the elements of non-obviousness, which are required to support a proper §103 analysis. According to M.P.E.P. §2143, to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to combine the references. Second, there must be a reasonable expectation of success. Third, the prior art combination of references must teach or suggest all the claim limitations.⁶ Applicant has identified how the Examiner has failed to provide any reference (or combination of references) that teaches or suggests all of the claim limitations. Thus, as an initial matter, the Examiner has failed to meet his burden with respect to the third criteria of non-obviousness.

With respect to the first criterion of non-obviousness, the Examiner has not shown a suggestion or a motivation in the references or in the knowledge generally available to one of ordinary skill in the art to combine the cited references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of making the combination.⁷ Thus, the fact that the teachings of one reference (*Furman*) would improve the teachings of another reference (*Whitehouse*), as posited by the Examiner, does not provide the required suggestion to make such a combination. Nothing in *Furman* or any other cited reference suggests or motivates the proposed combinations. Nor has the Examiner provided any evidence that suggests any of

⁶ See generally M.P.E.P. §2143.

⁷ See M.P.E.P. §2143.01.

the proposed modifications.⁸ The Examiner merely speculates that “it would have been obvious” to make the proposed combinations. The Examiner is merely interjecting a subjective conclusory statement in an improper hindsight attempt at rejecting the claims without citing any language from any of the cited references to support the rejection. The Examiner presents no objective evidence from the prior art that suggests or motivates the combination as is required by Federal Circuit caselaw.⁹ The M.P.E.P. also confirms that this approach is improper and, thus, it should not be used here.¹⁰

Furthermore, the Examiner is precluded from modifying the combined teachings of *Furman* and *Whitehouse* in an effort to teach the limitations of the pending claims because there is no indication in any of the references as to the desirability of making such modifications. The cited references must disclose the desirability of making the proposed modification.¹¹ The fact that the modification is possible or even advantageous is not enough.¹² A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.¹³

With respect to the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. The combinations of *Furman* and any of the references of record would not be capable of performing the operation required by the claimed invention. For example, there is no showing by the Examiner that the teachings of *Furman* would be able to provide “obtaining, at a first point, a first address and a first functional property code associated with the first

⁸ If the Examiner is relying on “common knowledge” or “well known” art in support of his rationale for combining the references, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. §2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine, Applicant respectfully requests that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. §2144.03.

⁹ In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Conclusory statements by the Examiner regarding the teaching of multiple references, standing alone, are not “evidence.” *Id.*

¹⁰ See M.P.E.P. §2145. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to lack of suggestion in the prior art of the desirability of combining references.”), See also *In re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”)

¹¹ *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

¹² See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

¹³ *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (See also M.P.E.P. §2141.02).

point to be routed” and “storing, at a data base, a second functional property code, a second address, and a third address associated with a second point” nor is there any disclosure relating to determining if the first functional property code is compatible with the second functional property code if the first address is compatible with the associated second address and sending the third address to the first point if the first functional property code is compatible with the second functional property code. The proposed combination (presumptively) attempts to combine divergent subject matter that has not been shown to be capable of operating according to any degree of predictability. The Examiner, without resorting to improper hindsight to look through the claimed invention, has not addressed the chance that the proposed *Furman-Whitehouse* combination would have any success whatsoever: let alone a reasonable expectation of success as is required. Therefore, Applicant respectfully submits that the Examiner has failed to establish the second criteria for a prima facie case of obviousness.

With respect to the third criterion of non-obviousness, the Examiner has not shown how the proposed combination teaches each and every limitation of the claimed invention. This has been evaluated thoroughly in the analysis provided supra. With no other supporting references that are combinable with *Furman*, all of the claim limitations have not been taught or suggested by the Examiner’s currently proposed combination. Therefore, Applicant respectfully submits that the pending claims are patentably distinct from the proposed combinations for the reasons enumerated supra. All of the pending claims have been shown to be allowable, as they are patentably distinct from each of the references of record. Notice to this effect is respectfully requested in the form of a full allowance of claims 1-154.

New Claims

Applicant adds Claims 155-168, which are fully supported by the Application as originally filed. New Independent Claim 155 recites:

A method for routing an object in a transportation network, comprising:

obtaining, at a first point, a first address and a stored code associated with an object to be routed;

determining whether to use the stored code or an alternative property code as a first functional property code based on whether a user provides the alternative property code;

storing, at a data base, a second functional property code, a second address, and a third address, which is associated with a second point;

determining if the first address is compatible with the second address;

determining if the first functional property code is compatible with the second functional property code if the first address is compatible with the second address; and

sending the third address to the first point if the first functional property code is compatible with the second functional property code.

Neither *Furman* nor *Whitehouse* disclose “determining whether to use the stored code or an alternative property code as a first functional property code based on whether a user provides the alternative property code” as recited by Independent Claim 155. Indeed, both *Furman* and *Whitehouse* suffer from similar deficiencies in that neither inhibit the patentability of any of the pending claims. Thus, Independent Claim 155 is allowable for at least this reason. Notice to this effect is respectfully requested in the form of a full allowance of Independent Claim 155 and its corresponding dependent claims.

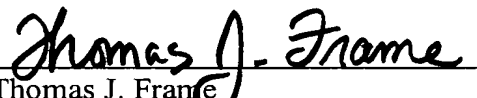
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

Applicant includes a check in the amount of \$169.00 to cover the cost of the additional claims. If this is not correct, the Commissioner is hereby authorized to charge additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,
BakerBotts L.L.P.
Attorneys for Applicant


Thomas J. Frame
Reg. No. 47,232

Date: November 14, 2003

CORRESPONDENCE ADDRESS:

Baker Botts L.L.P.
2001 Ross Avenue, 6th Floor
Dallas, Texas 75201
(214) 953-6675
(214) 661-4675 - Fax

